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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,560	10/13/2006	John Waterfield	ENI-355-A	1844
48980 7590 07/20/2007 YOUNG & BASILE, P.C. 3001 WEST BIG BEAVER ROAD SUITE 624 TROY, MI 48084			EXAMINER PARKER, FREDERICK JOHN	
			ART UNIT 1762	PAPER NUMBER
			NOTIFICATION DATE 07/20/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@youngbasile.com  
audit@youngbasile.com

**Office Action Summary**

Application No.

10/553,560

Applicant(s)

WATERFIELD, JOHN

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-14-08</u> | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 1 is vague and indefinite because (1) line 9, it is unclear if the ink simply CAN be dried using UV or IS dried using UV; and (1) line 10, it is unclear if the filler is simply CAPABLE of imparting non-slip properties or does impart them. Positive recitations are recommended.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Admitted Prior Art (APA).

The APA teaches it is known to apply screen printed, abrasion resistant inks as patterns onto clear plastic surfaces which impart abrasion resistance. The patentability of a product is based upon the product itself as claimed, and not upon its method of production. If the product of a product-by-process claim is the same or obvious from a product of the prior art, it is unpatentable even though the processes of making may be different. It is the burden of Applicant to establish an unobvious difference between the claimed product and that of the prior art, MPEP 2113.

6. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schafer WO 97/09179 in view of the APA and Gust US 2002/0110647

Schafer teaches an improved measuring device/ ruler in which a transparent material, especially acrylic, is screen printed with thick lines to form multi-colored gradations which form the measuring units in at least one stage (pages 1,2,7,8 and elsewhere). The printing of "UV curable inks per claim 4 is taught (page 3, top). While non-slip characteristics is not cited, the APA states on page 1 that it is known and conventional in the art that rulers require non-slip characteristics which are imparted by additions of a filler such as fine sand or pumice to applied coatings. Given that knowledge, one of ordinary skill would have looked to slip resistant coatings for application to the device/ ruler of Schafer, and therefore have used the teachings of

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Gust et al which cite the use of clear UV curable coatings comprising similar filler materials (e.g. silicon dioxide, which encompasses "sand", ground glass, glass beads, etc per claim 3) which imparts handling, scratch resistance or other attributes [017]. Given the similarity of fillers, the coating would have been expected to impart slip resistance. When a reference discloses the limitations of a claim except for a property, and the Examiner cannot determine if the reference inherently possesses that property (in this case, slip resistance ), the burden is shifted to Applicant/s, In re Fitzgerald 205 USPQ 594 and MPEP 2112. Such UV coatings, which may contain photo initiators [030 and examples, etc] (claim 2) cure immediately on contact with UV, providing the obvious benefit of rapid curing versus slower curing coatings [0027]. Polymer substrates are cited for such coatings, including previously coated polymer surfaces [0032,0034, 0037,etc].

The product of claims 5-6 would have been obvious in view of the prior art rejections above, and therefore would be unpatentable.

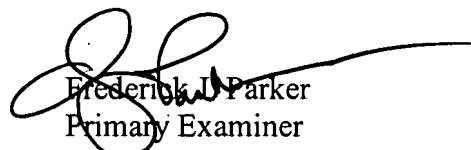
It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the ruler/ device of Schafer using screen printing to form gradations and further imparting non-slip characteristics known according to the APA by further substituting or incorporating as topcoats the UV curable clear coatings containing fillers of Gust et al to provide the ruler with a wear and slip resistant surface formed by the rapid UV curing method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Frederick J. Parker  
Primary Examiner  
Art Unit 1762

FJP